

**REMARKS**

Claims 1, 2, 13, 21 and 26-29 and 31 are the only currently active claims pending in this application. This paper cancels claims 14, 20 and 30. The foregoing separate sheets marked as "Listing of Claims" show all the claims in the application, each with an indication at its first line showing its current status.

**I. Claims 1, 2, 13, 21 and 26-28**

The Office Action rejects claims 1, 2, 13, 21 and 26 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,061,719 ("Bendellini"). See Office Action at pages 3-7.

Applicants respectfully traverse the rejection. Applicants respectfully submit that Bendellini lacks structure and functions meeting the broadest reasonable meaning of Applicants' claim elements and their recited arrangement and, therefore, respectfully request that the rejection be reconsidered and withdrawn.

Bendellini, to the extent it can be understood, discloses a system that broadcasts a television signal having embedded URL signals, which is received by a set-top box 34 or decoder 52 atop a user's television. The set-top box 34 or decoder 52 "extract" the URL signal and display it as a caption on the user television, synchronized with the television program. See Bendellini, at column 4, lines 29-36; at column 5, lines 33-37; and at column 6, lines 2-6. If the user is interested in the URL in the caption box, then he or she enters a command into the unit 34 or 52 it and, in response, a web-browser in the set-top box 34 or decoder 52 connects to the Internet, retrieves the corresponding web page and displays its content, either on the user's television or on the user's computer. See Bendellini, at column 4, lines 47-52; and at column 5, line 58 through column 6, line 2.

Bendellini's set-top box 34 and decoder 52 do not "store customer information data representing attributes of a customer," which is a limitation of each and every of Applicants' pending active claims. See claim 1, lines 3-4;

claim 2, lines 5-6; claim 13, line 2; and claim 21, lines 3-5. Bendellini stores nothing other than the URLs that the browser in the set-top box 34 or decoder 52 was commanded to visit, or that the unit 34 or 52 extracted. See Bendellini, at column 5, lines 46-57. Therefore, for this and other reasons, Bendellini cannot anticipate any of Applicants' pending claims.

Bendellini's set-stop box 34 and decoder 52 do not generate any customer-specific advertisement that is based on a "customer information data representing attributes of a customer" - which is a limitation of each and every of Applicants' pending, active claims. See claim 1, lines 7-9; claim 2, at lines 9-11; claim 13, lines 4-5; and claim 21, lines 10-11. Bendellini's set-top box 34 and decoder 53 receive a television signal with embedded URLs, from the "Broadcast Transmitter" 2, display the URLs as text on the user's television 34 and, if the user enters a command, the unite 34 or 52 browser visits the corresponding web page and displays it to the user. Therefore, for this additional reason, Bendellini cannot anticipate any of Applicants' pending claims.

Bendellini's set-stop box 34 and decoder 52 do not transmit any customer-specific advertisement based on, or to a destination based on, "a destination address (or) customer address corresponding to said customer" - which is a limitation of each and every of Applicants' pending, active claims. See claim 1, lines 9-10; claim 2, at lines 8-9; claim 13, lines 5-6; and claim 21, lines 12-13. Bendellini's set-top box 34 and decoder 53 only receive a television signal with embedded URLs, send the URLs as text to the user's television 36, and, if the enters a command, the browser visits the corresponding web page and sends the content to, and only to, the user's computer 54 or television 36. Therefore, for this additional reason, Bendellini cannot anticipate any of Applicants' pending claims.

### **Claim 1**

Applicants' claim 1 recites: (i) "means for storing a customer information data representing attributes of a customer"; (ii) "means for generating a first information data reflecting a predetermined advertisement"; (iii) "means for

generating a customer-specific advertisement data ... based on the customer information ... and including a communication address corresponding to said customer; (iv) “a first information transmission path”; and (v) “a second information transmission path.” Claim 1, lines 3-15

The above-enumerated elements (i) –(iii) of claim 1 are means-plus-function elements. See MPEP § 2181.

To embody a means-plus-function element, a prior art reference must, at least, “perform[] the function specified in the claim,” and must perform the function with a structure equivalent to the structure(s) that the specification and drawings show for performing the function. MPEP § 2183.

Means-plus-function language must be given its “broadest reasonable meaning,” i.e., the ordinary, customary meaning that one of ordinary skill would understand upon reading the claim, the specification and drawings. See MPEP § 2111, 2183. Other evidence of the “ordinary and customary meaning includes ... dictionaries.” MPEP § 2111.01(III).

Regarding the claim 1 element of: “means for storing a customer information data representing *attributes of a customer*,” Applicants respectfully submit the dictionary definition of “*attribute*,” which is:

- a** *a quality ascribed to a person or thing:*
- b** *a characteristic quality.*

Oxford Illustrated American Dictionary (1998), at page 59.

Turning to Applicants’ specification, example support for the “means for storing ... attributes of a customer” is a description of storing data representing customer-descriptive information of *name, nationality, gender, address* and date of birth, for use in generating customer-specific (e.g. “my page”) advertisements. See Specification, at page 41, lines 3-18. The supporting description conforms to the dictionary meaning of “attributes.”

Applicants therefore respectfully submit that the broadest reasonable meaning of “storing a customer information data representing *attributes of a customer attributes of a customer*” is: a storing characteristics or qualities of a

particular customer, such as for, example, the customer's gender name, nationality, sex, address and date of birth.

Applicants' specification and drawings disclose only one structure for performing this "storing a customer information" function - the Fig. 1 Information Management Center 3, Network N, and User Terminals 4.1, 4.2. See Specification, at page 41, lines 3-18.

For Bendellini to embody this "means for storing a customer information" it must perform the function of storing attributes of a customer, which are characteristics or qualities of the particular customer, such as for, example, the customer's gender name, nationality, sex, address and date of birth, and must do so with structure equivalent to that described by Applicants' specification and drawings. Bendellini does not perform the function and does not have the structure.

The Office Action identifies Bendellini's set-top TV box 34 as embodying the claim 1 "means for storing a customer information data representing attributes of a customer." Office Action at page 3.

Applicants respectfully submit that the Office Action is in error - Bendellini does not perform any function within the broadest reasonable meaning of "storing a customer information data representing attributes of a customer."

Bendellini's set-top box 34 and decoder 52 store a list of the last several URLs that have been "extracted," *i.e.*, a list of URLs previously displayed on the television 36 or computer 54 or the web pages that some person or persons commanded the browser of the set-top box 34 or decoder 52 to display. See Bendellini, at column 5, lines 50-54.

Applicants submit that URLs are nothing more than what their acronym represents: Uniform Resource Locators; they do nothing more than address an Internet resource. URLs are not "*attributes*" of persons.

Further, Bendellini's set-top box 34 does not receive, store or associate the URLs with person(s); it simply stores the list of URLs extracted or clicked on – by whoever used the set-top box 34. Therefore even if URLs were argued as being "attributes," which they are not, there is nothing in Bendellini associating

the list of URLs that people have clicked on with any particular person, i.e., with “a customer.”

Bendellini’s set-top box 34 therefore cannot embody the claim 1 “means for storing a customer information data representing attributes of a customer”; it does not store “attributes” and it does not store “attributes of a customer.”

Claim 1 also recites a “means for generating a first information reflecting a predetermined advertisement.” Claim 1, previously presented, at lines 5-6.

The Office Action’s position is that Bendellini’s set-top box 34 also embodies the claim 1 “means for generating a ... predetermined advertisement.” Office Action, at page 3.

Applicants respectfully submit that the Office Action is in error, as it improperly ignores the structural limitations of this means element.

To identify the structural scope of a means-plus-function element, the function is first identified. See MPEP § § 2181-2183. Turning to the subject element, the function is generating “a predetermined advertisement.” The only structure disclosed by Applicants’ specification and drawings for performing the recited function is the “Broadcast Station” shown as item 2 in Fig. 1. The Broadcast Station 2 is disclosed as separate from the Information Management Center 3, connected via the Network N. The “means for generating a ... predetermined advertisement” element is therefore limited to the Broadcast Station 2 or its equivalent. See MPEP § § 2181-2183.

The Office Action’s position is that Bendellini’s set-top box 34 embodies the claim 1 “means for storing a customer information” and embodies the claim 1 “means for generating ... a predetermined advertisement.”

Applicants’ specification, however, shows the “means for storing” function as performed by the Information Management Center 3, and shows the “means for generating ... a predetermined advertisement” function as performed by the Broadcast Station 2, connected to the Information Management Center 3 by the Network N.

The Office Action’s position appears to ignore the 35 U.S.C. § 112, ¶ 6 structural limitations of these claim 1 means elements, because Bendellini’s set-

top box 34 and decoder 52 are not structurally equivalent to Applicants' disclosed Information Management Center 3 and Broadcast Station 2, connected by Network N.

Claim 1 further recites

means for generating a customer-specific advertisement data based, at least in part, on said customer information data and said first information, and including a communication address corresponding to said customer

Claim 1, lines 7-10.

The Office Action's position is that Bendellini's set-top box 34 embodies this claim 1 "means for generating a customer-specific advertisement data." Office Action, at page 3, second-to-last line, through page 4, line 7.

The Office Action's basis for this position includes a statement that the "embedded URL in the television signal for display on a different window," at Bendellini, column 6, lines 31-39, "include[es] a communication address corresponding to said customer." Office Action, at page 4, lines 5-7.

Applicants respectfully respond that the Office Action is in error.

First, the function of the "means for generating a customer-specific advertisement" requires the data to "includ[e] a communication address corresponding to said customer," (emphasis added) Claim 1, at lines 9-10. The claim also recites: transfer[ring] said customer-specific advertisement ... to a destination based on said communication address." Claim 1, lines 13-15.

Bendellini's set-top box 34 and decoder 52 do not perform the above-underlined functions. Bendellini at column 6, lines 31-39, describes URLs embedded in the television signal received by the set-top box 34 or decoder 52. The set-top box 34 outputs a television program picture and URL caption to the user's television 36 and web page, to the user's television 36. None of these outputs has a "communication address." They simply feed directly into the television 36. Likewise, Bendellini's decoder 52 has three outputs, two are connected directly to the user's television 36, and one is connected directly to the users computer 54. None of these outputs has a "communication address."

Second, neither Bendellini's set-top box 34 nor Bendellini's decoder 52 store anything that is even arguably equivalent to the claim 1 "customer information data representing attributes of a customer." Since neither of these items 34 and 52, nor anything else in Bendellini, store any such "customer information" they cannot possibly generate, or teach anything of generation of an advertisement based on such "customer information."

For at least the two reasons above, Bendellini cannot embody the claim 1 "means for generating a customer-specific advertisement data."

Claim 1 further recites: "a first information transfer path for transmitting said first information data to a plurality of destinations." Claim 1, lines 11-12.

The Office Action's position is that the antenna or cable by which Bendellini's set-top box 34 receives the television signal with embedded URLs, i.e., from the "broadcast transmitter 32) meets the claim 1 "first information transfer path." Office Action at page 4, lines 7-9.

Applicants respectfully submit that the Office Action's position is in error; it interprets Bendellini a first way in relation to one claim 1 element, and then a second way in relation to another claim 1 element.

More specifically, the claim 1 "first transmission path" transfers "a first information data" or "predetermined advertisement" from its "means for generating a first information" to "a plurality of destinations." The Office Action's position at page 3 is that Bendellini's set-top box 34 and decoder 52 meet the claim 1 "means for generating a first information data." Claim 1, though, recites the "first transfer path" as transferring the "first information data," to "a plurality of destinations." Claim 1, lines 11-12. The Office Action reads this "first information path" onto Bendellini by apparently shifting its page 3 position, to a different position page 4, namely that the Broadcast Transmitter 32 embodies the claim 1 "means for generating a first information data." The shift in position is created by reading the claimed "first transmission path" onto the input to Bendellini's set-top box 34 and decoder 52 (i.e., the television signal with embedded URL sent by the Broadcast Transmitter 32.) Applicants respectfully submit that this shift in interpreting Bendellini is improper.

Claim 1 further recites: “a second information transfer path for transmitting said customer-specific advertisement data to a destination path based on said communication address.” Claim 1, lines 13-15.

The Office Action’s position is that the antenna or cable by which Bendellini’s set-top box 34 or decoder 52 receives the television signal with embedded URLs, i.e., from the “broadcast transmitter 32) meets the claim 1 “second information transfer path.” Office Action at page 4, lines 9-12.

Applicants respectfully submit that the Office Action’s position is in error because, to read this “second information path” onto Bendellini, it again shifts its position from that stated at page 3, (namely that Bendellini’s set-top box 34 and decoder 52 embody the claim 1 “means for generating a customer-specific advertisement) to that stated at page 4, which is that the inputs to Bendellini’s set-top box 34 and decoder 52 somehow embody the “second transmission path.” Applicants respectfully submit that the Office Action is in error.

Applicants, for the foregoing reasons, respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

### **Claim 2**

Applicants respectfully submit that Bendellini lacks at least the following elements of claim 2: (i) “first information providing means”; (ii) second information providing means”; and (iii) “an information receiving terminal.”

Bendellini lacks the “first information providing means” because, among other reasons, it lacks “a predetermined advertisement,” transmitted “to a plurality of destinations ... via a first information transfer path.” Claim 2, lines 2-4. Bendellini’s set-top box 34 and decoder 52 do not transmit output to a “plurality of destinations.” Instead, Bendellini’s unit 34 connects directly to the television 36 and, regarding unit 54, two outputs connect directly to the user’s television 36 and one output connects directly to the user’s computer 54. Bendellini does not show anything within the meaning of “first information transfer path.” See Applicants’ above response to the rejection of claim 1.



Bendellini lacks the “second information providing means” because it lacks two of the elements’ further means-plus-function elements - “means for storing a customer information data representing attributes of a customer” and “means for generating ... a customer-specific advertisement data ... based, at least in part, on said customer information data and on said first information data.” Claim 2, lines 5-11. As Applicants have submitted above, with respect to claim 1, Bendellini’s set-top box 34 and decoder 52 store only a list of the URLs that persons have clicked on. This is not “customer information data representing attributes of a customer.” Bendellini generates nothing based on “customer information data.” See Applicants’ above response to the rejection of claim 1.

Bendellini lacks the “second information providing means because it lacks the function of generating the “customer-specific advertisement data ... having a destination address corresponding to said customer,” that is transferred “via a second information transfer path.” *Id.* As Applicants have submitted above with respect to claim 1, Bendellini does not generate a “customer-specific advertisement having a destination address corresponding to said customer.” Restated in part, Bendellini’s unit 34 connects directly to the television 36 and, regarding unit 54, two outputs connect directly to the user’s television 36 and one output connects directly to the user’s computer 54. The outputs of the set-top box 34 and the decoder 52 are not addressed; they are connected to a fixed destination – the user’s television 36 and/or the user’s computer 54. See Applicants’ above response above to the rejection of claim 1.

Further regarding this claim, as Applicants have submitted above, Bendellini does not teach, disclose or suggest anything meeting the limitations of the “first information transfer path,” or the “second information transfer path.” See Applicants’ above response to the rejection of claim 1.

### **Claim 13**

Applicants respectfully submit that Bendellini lacks at least the following elements of claim 13: (i) “storing a customer information data representing attributes of a customer”; (ii) transmitting an advertisement data via a first

information transfer path; (iii) “[transmitting] a customer-specific advertisement data based on said advertisement data and said customer data”; (iv) [transmitting the customer-specific advertisement data to have] a destination address corresponding to said specific customer”; (v) [transmitting said customer-specific advertisement data] via a second information transfer path”; (vi) “said transmitting of said advertisement ... to a plurality of customers”; and (vii) said transmitting of said customer-specific advertisement is, in accordance with said destination address.”

Bendellini does not store “a customer information data representing attributes of a customer” for the same reason that it does not have the claim 1 or claim 2 “means for storing” such information. In summary, Bendellini stores the list of URLs that users of the set-top box 34 or the users of the decoder 52 have clicked on. A list URLs clicked on is simply not within the broadest reasonable meaning of “storing a customer information data representing attributes of a customer.”

Bendellini does not disclose, teach or inherently perform storing transmit “an advertisement data via a first information transfer path” for the same reasons that it does not have the claim 2 “means for transmitting an advertisement data” and the same reasons it does not have the claim 1 and claim 2 “first information transfer path.” See Applicants’ Remarks responding to the rejection of claim 1 and claim 2.

Bendellini does not disclose, teach or inherently perform transmitting “a customer-specific advertisement data based on said advertisement data and said customer data” for the same reasons that it does not have the claim 1 and claim 2 “means for generating a customer-specific advertisement data.” The reasons include Bendellini not storing “attributes,” which means that Bendellini does not generate anything, from anywhere, based on “attributes.” See Applicants’ Remarks responding to the rejection of claim 1 and claim 2.

Bendellini does not disclose, teach or inherently perform transmitting the customer-specific advertisement data to have “a destination address corresponding to said specific customer” for the same reasons that it does not

have the claim 1 and claim 2 means for generating or transmitting a customer-specific advertisement data based on "said destination address corresponding to said specific customer." The reasons include Bendellini's set-top box 34 connecting directly to the user's television, and Bendellini's decoder 52 connecting directly to the user's television and computer. Stated differently, the connection between the set-top box 34, or the decoder 52 and the television and personal computer is not an addressed transfer. See Applicants' above Remarks responding to the rejection of claim 1 and claim 2.

Further regarding this claim, as Applicants have submitted above, Bendellini does not teach, disclose or suggest anything meeting the limitations of the "first information transfer path," or the "second information transfer path." See

#### **Claim 21**

Applicants' claim 21 is a Beauregard claim corresponding to method of claims 13. Applicants respectfully submit that Bendellini lacks multiple elements of each of claim 21 for the same reasons it lacks corresponding multiple elements of claim 13. See Applicants' above Remarks responding to the rejection of claim 13.

#### **Claims 26-28**

Applicants respectfully submit that claims 26-28 and 31 are each dependent, or ultimately dependent, on base claim 2, and are therefore combination claims having, in addition to their own limitations, all of the limitations of claim 2. Therefore, these claims are patentable over Bendellini, for at least the reasons Applicants have shown for claim 2 above. See Applicants' above Remarks responding to the rejection of claim 2.

## **II. Claims 29 and 31**

The Office Action rejects claims 29 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Bendellini I view of U.S. Patent No. 6,446,130 (Grapes"). See Office Action at pages 8-11.

Applicants respectfully traverse the rejection, on the grounds that claims 29 and 31 depend from claim 2, and that the combined disclosures of Bendellini and Grapes lack at least all of the elements of claim 2 that Bendellini lacks.

Restated here, Bendellini lacks at least the following elements of claim 2: (i) “first information providing means”; (ii) second information providing means”; and (iii) “an information receiving terminal.”

Bendellini lacks the claim 2 “first information providing means” because, among other reasons, it lacks the function of “a predetermined advertisement,” transmitted “to a plurality of destinations ... via a first information transfer path.” Claim 2, lines 2-4. Bendellini’s set-top box 34 and decoder 52 do not transmit output to a “plurality of destinations.” Bendellini’s unit 34 connects directly to the television 36 and, regarding unit 54, two outputs connect directly to the user’s television 36 and one output connects directly to the user’s computer 54. Bendellini does not show anything within the meaning of “first information transfer path.” See Applicants’ above response to the rejection of claim 2.

Grapes teaching nothing relating to this “first information providing means.”

Bendellini also lacks the claim 2 “second information providing means” because, among other reasons, it lacks a “means for storing a customer information data representing attributes of a customer,” and a “means for generating ... a customer-specific advertisement data ... based, at least in part, on said customer information data and on said first information data.” Claim 2, lines 5-11. Bendellini’s set-top box 34 and decoder 52 store only a list of the URLs that persons have clicked on. This is not “customer information data representing attributes of a customer.” See Applicants’ above response to the rejection of claim 2.

Grapes teaches nothing relating to this claim 2 “means for storing” element.

Bendellini also lacks the “second information providing means” because it lacks the function of the “customer-specific advertisement data ... having a destination address corresponding to said customer,” that is transferred “via a

second information transfer path.” *Id.* As Applicants have submitted above with respect to claim 1, Bendellini does not generate a “customer-specific advertisement having a destination address corresponding to said customer.” Bendellini’s unit 34 connects directly to the television 36 and, regarding unit 54, two outputs connect directly to the user’s television 36 and one output connects directly to the user’s computer 54. See Applicants’ above response above to the rejection of claim 2.

Grapes teaches nothing relating to the base claim 2 “customer-specific advertisement data ... having a destination address corresponding to said customer,” that is transferred “via a second information transfer path means for storing.”

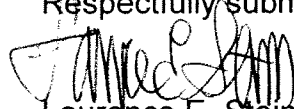
### **Conclusion**

In view of the foregoing, Applicants respectfully request that the application be reconsidered, that claims 1, 2, 13, 21, 26 to 29, and 31 be allowed and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: mike@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If any further extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such additional extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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